

REMARKS

The Office Action dated January 16, 2004 has been carefully reviewed, and the following remarks are made in response thereto. In view of the above claim amendments and following remarks, Applicants respectfully request reconsideration and reexamination of this application and timely allowance of the pending claims.

By this Amendment, claims 32-37 have been amended. Support for the amended claims can be found on page 3, line 27, page 7, lines 7-21, page 15, lines 14-19 and page 21, lines 9-13. Applicants note that each fragment name in the tables, for instance in Table 5, corresponds to an “Affymetrix element” (probe sequence) in Tables 3 and 4. Each element in Tables 3 and 4 corresponds to a GenBank Accession number, which in turn, corresponds to a SEQ ID NO in the sequence listing (the sequence listing comprises the individual sequences of the references (GenBank numbers). For example, rc_AA227926 is listed as the first down-regulated sequence in Table 5. This Affymetrix element is in the approximate middle of page 58 of Table 4. The SEQ ID No. corresponding to this fragment is SE ID NO. 136. Applicants respectfully submit that no prohibited new matter has been introduced by the amendments.

Summary of the Office Action

1. Claims 32-38 and 55-56 are pending. Claims 1-31, and 39-54 have been cancelled.
2. The references in Applicants’ IDSs filed on June 11, 2002 and August 21, 2002 have been lost by the Patent Office. Submitted with this response are replacement copies of the references.
3. The abstract is objected to for not being directed to the subject of the invention. Submitted with this response is a replacement abstract.
4. The specification is objected to for not correctly stating the priority information. Submitted herein, is an updated priority claim.
5. Claims 33-38 are objected to for not beginning with the word “The.”

Response to the Office Action

Rejection of claims 32-38 and 53 under 35 U.S.C. §112, 1st paragraph

The Office Action alleges that Applicants have failed to comply with the written description requirement and that the claimed subject matter was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims have been amended to recite “nucleic acid molecule” instead of gene. The nucleic acid molecules comprise a set, wherein each nucleic acid molecule in the set corresponds to a SEQ ID NO in the sequence listing, the sequence listing comprising the nucleic acid sequence for each of the GenBank numbers recited in the Tables. Although clear from the specification, the relationship between the “Affymetrix element” and each of the SEQ ID NOS is explained above.

The Examiner has also indicated that Tables 1-6 do not provide the absolute expression level for the recited nucleic acid molecules in BPH tissue or cells. Applicants have amended the claims to require that the database merely comprise information corresponding to the expression levels of the recited nucleic acid molecules in BPH tissue or cells. As an example of such information corresponding to the expression level of the various nucleic acid molecules in BPH tissue or cells that is contained within the database, the Examiner is respectfully directed to the data of Tables 1-6, all of which corresponds to the expression level of nucleic acid molecules corresponding to SEQ ID NOS 1-1124. Withdrawal of the rejection is earnestly requested.

Rejection of claims 32-38 and 53 under 35 U.S.C. §112, 2nd paragraph

Claims 32-38 and 53 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claim 32 now recites a “set of nucleic acid molecules” as does amended claim 33. Again, these nucleic acid modules correspond to SEQ ID NOS: 1-1124.

Claim 37 has been amended to delete the term “descriptive.”

Claim 53 has been cancelled.

Applicants respectfully request that these rejections be withdrawn.

Claim Rejections under 35 U.S.C. §103

Claims 32-38 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maslyn *et al.* (USPN 5,953,727).

Respectfully, as admitted by the Examiner, Maslyn *et al.* do not teach a computer system comprising a database, wherein the database comprises information corresponding to the expression level of the claimed set of genes in BPH tissue or cells. Further, the claims as amended require a software component that functionally links the database information to the ability of a user to compare sample data to the information in the database. As such, the claimed computer system comprises data structures of gene expression information and software which imparts functionality to the computer component. See MPEP § 2106 IV(B)(1). Respectfully, for these reasons Maslyn *et al.* do not render the claimed invention obvious and the rejection should be withdrawn.

Conclusion

The foregoing remarks are being made to place the application in condition for allowance. Applicants respectfully request reconsideration and timely allowance of the pending claims. A favorable action is awaited. Should the Examiner find that an interview would be helpful to further prosecution of this application, she is invited to telephone the undersigned at her convenience.

If there are any fees due in connection with the filing of this amendment, please charge the fees to our Deposit Account No. 50-310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Except for issue fees payable under 37 C.F.R. 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **constructive petition for extension of time** in accordance with 37 C.F.R. 1.136(a)(3).

Dated: July 16, 2004

Morgan, Lewis & Bockius LLP
Customer No. 09629
1111 Pennsylvania Ave., N.W.
Washington, D.C. 20004
202-739-3000

Respectfully submitted
Morgan, Lewis & Bockius LLP

Michael S. Tuscan
Michael S. Tuscan
Registration No. 43,210